

## REMARKS

### Introduction

Claims 1-27 are pending, with claims 1, 8, 15 and 22 having been amended herein. No new matter has been presented. Reconsideration of the patentability of the claimed subject matter is requested in view of the foregoing amendments and following discussion.

### § 102 Rejection

Claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 18, 19, 21-23, 25 and 27 have been rejected under 35 U.S.C. §102(b) as being anticipated by Wild et al., U.S. Patent No. 5,862,480 ('*Wild*').

Independent claim 1, as amended, recites, inter alia, the step of associating one or more alternative network link designations with one or more of said network links based upon a priority order assigned by the user of said computer system and also recites that the priority ordering is stored on the computer system. The Wild reference does not disclose these features of independent claim 1.

Wild describes a process in the which a subscriber unit (SU) attempts to gain access to another network. Col. 9, lines 36-40. In this process, after a number of steps have been performed, *an access server* compiles a list of available networks to which the SU is permitted access, and then returns this list to the SU. As Wild explains:

In a preferred embodiment, the list of accessible networks can be returned to the requester in a prioritized order or with the priority otherwise indicated. The prioritization of the list can be based on which network provides the lowest service rate, the best quality communications, or which network has the most available capacity, for example. ***Prioritization of the list can depend on preference information from the SU or the GW (e.g., a request to priority based on lower service rate)***, the order of the RF capabilities in the SU RF capabilities message (e.g., if 900 MHz is a first-listed RF capability, then networks which operate at 900 MHz will be of higher priority), or a default prioritization scheme (e.g., best speech quality is always of highest priority).

(*Wild*, col, 10, lines 45-58; emphasis added).

As the above-quoted section of Wild makes clear, the list of accessible networks is generated at the access server and the prioritization of the list is also determined at the access

server and then provided to the user. While Wild indicates that the prioritization of the list generated at the access server may depend on preference information from the SU, at most Wild discloses and suggests that the user provides a criterion for prioritization to the access server, which then determines the priority order according to the criterion. The user does not set the prioritization of the networks *per se*.

An illustrative example shows the clear difference between what is claimed and the teachings of Wild. According to Wild, a user may indicate a preference for ordering based on a set criterion such as service quality in which case, for example, the access server may provide a priority order of Networks A, B and C (A then B then C). However, the user may, for some reason, prefer to use network C over network B, despite the superior quality of service of network B. According to the present invention, the user can assign alternative networks such that a requesting device will attempt to connect to A then C then B, rather than A then B then C. Note that this can be done despite the fact that network B may have superior characteristics to network C according to a set criterion due to the fact that the ordering is performed and stored by the requesting computing system.

In sum, the claimed subject matter differs from the teachings of Wild in (at least) two important ways: (1) the priority order of the alternative networks is assigned by the user at the requesting computing system and relatedly, (2) the order is readily configurable since it is also stored at the requesting computing system, allowing a user to set alternative networks according to any reasons, criterion or preferences (even arbitrary) rather than having a server automatically determine the order of alternative networks based on a preset criterion.

For these reasons, it is submitted that Wild does anticipate the subject matter of independent claim 1 and its dependent claims 2, 4, 5 and 7.

As independent claims 8, 15 and 22 have been amended in like manner to claim 1, it is submitted that Wild likewise does not anticipate the subject matter of claims 8, 15 and 22 and their respective dependent claims 9, 11, 12, 14, 16, 18, 19, 21, 23, 25 and 27.

Withdrawal of the rejection of claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 18, 19, 21-23, 25 and 27 under 35 U.S.C. §102(b) based on Wild is therefore respectfully requested.

## § 103 Rejection

### Governing Legal Principles

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Additionally, to resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper, so that the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *See In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002).

Furthermore, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

### Discussion

Claims 3, 6, 10, 13, 17, 20, 24 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wild in view of Horn, U.S. Patent No. 6,192,414 ('Horn'). It is submitted that claims 3, 6, 10, 13, 17, 20, 24 and 26 are patentable over the combination of Wild and Horn, because (1) the Horn reference does not cure the deficiencies of the Wild reference and (2) there is no suggestion to modify the teachings of Horn to combine with the teaching of Wild or vice versa, in order to arrive at the claimed subject matter.

Claims 3, 6, 10, 13, 17, 20, 24 and 26 depend from and incorporate the features of their respective independent claims 1, 8, 15 and 22.

The Horn reference refers to a redundancy scheme in which a network manager prepares a plurality of transport service providers (TSPs) for establishing a network connection

simultaneously. See Horn, col. 3, lines 44-51. Like the Wild reference, Horn does not provide for associating one or more alternative network link designations with one or more of said network links based upon a priority order assigned by the user of said computer system and also recites that the priority ordering is stored on the computer system. Instead, Horn at most teaches (and suggests) using a 'health manager' to determine which of two or more available networks to send data through. In this regard, Horn provides:

If a program wishes to transmit information, in step 444 a health report established by the health manager 42 is reviewed. Using the predetermined redundancy/backup scheme, the status report and the health report, in step 446, the transmission manager 44 determines which is the most suitable connection to use.

(Horn, col. 8, lines 42-48)

As Horn teaches an automatic connection selection process that does not allow the user to set the priorities of the alternative network links, it is submitted that it does not cure the deficiencies of the Wild reference as discussed above.

Furthermore, due to the different principles of operation between the methods disclosed in the Wild and Horn references, there would have been no reason for those of skill in the art at the time of the claimed invention to have combined or modified the teachings of either reference in view of the other. In particular, Wild describes a method whereby a subscriber unit (e.g., a mobile phone) in a geographic zone is able to obtain information about other networks that are available to it in the zone so that a handoff can occur. Thus, in Wild, a subscriber unit obtains information about available networks so that the subscriber unit may switch from one network to another.

In contrast, according to Horn, a plurality of transport servers providers are prepared for establishing a connection. Notably, the computing device attempting to establish a connection does not query or obtain information about available networks prior to establishing a connection. Thus, the various teachings for which the Examiner consults the Horn reference (e.g., re-attempting to establish a connection using a first network link) would not be useful in the context of Wild. For example, reattempting to establish a first connection after an attempt to establish an alternate connection (as purported disclosed by Horn) would not be a useful procedure in a handoff procedure according to Wild, because Wild predetermines the availability of alternate

networks, and if such availability is lacking, a handoff does not occur, and the first network connection (from which the subscriber unit seeks to disconnect upon finding another suitable network) is not disconnected.

For these additional reasons, it is submitted that the combination of Wild and Horn does not render obvious the subject matter of claims 3, 6, 10, 13, 17, 20, 24 and 26. Withdrawal of the rejection of these claims under 35 U.S.C. §103(a) is accordingly respectfully requested.

### ***Conclusion***

All of the stated grounds of rejection have been properly addressed. Applicants therefore respectfully request that the Examiner reconsider the outstanding rejections. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: March 14, 2008

By: /Howard Grossman/  
Howard Grossman  
Registration No. 48,673  
Phone: 212-871-6266

### Correspondence Address

**Cust. No. 49637**

Berry & Associates, P.C.  
9255 Sunset Boulevard, Suite 810  
Los Angeles, CA 90069  
Phone: (310) 247-2860  
Fax: (310) 247-2864